



GAV 3763

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PTO/SB/21 (08-00)

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**TRANSMITTAL
FORM**

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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/097,023	
	Filing Date	June 12, 1998	
	First Named Inventor	Jill McFADDEN	
	Group Art Unit	3763	
	Examiner Name	M. Thompson	
Total Number Of Pages In This Submission	4	Attorney Docket No.	290252021800

ENCLOSURES (check all that apply)

<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input checked="" type="checkbox"/> Amendment / Reply - 3 pages	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declarations	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	1. Return postcard
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application	Remarks	
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TC 3700 MAIL ROOM**SIGNATURE OF APPLICANT, ATTORNEY OR AGENT**

Firm or Individual Name	Morrison & Foerster LLP, 755 Page Mill Road, Palo Alto, California 94304-1018
Signature	Johney U. Han (Registration No. 45,565)
Date	February 13, 2001

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Laura Shires

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Laura Shires
Laura Shires

M. Thompson
Chapman
22507

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

Jill MCFADDEN et al.

Serial No.: 09/097,023

Filing Date: June 12, 1998

For: CATHETER WITH KNIT SECTION



Examiner: M. Thompson

Group Art Unit: 3763

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RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This is in response to the Restriction Requirement dated January 18, 2001 (Paper No. 16) for which a response was due on February 17, 2001. Accordingly, this response is timely filed.

Applicants hereby elect Group I (claims 1-15, 17-22, 24-30, and 54-57) with traverse. Applicants expressly reserve the right under 35 U.S.C. § 121 to file a divisional application directed to the non-elected subject matter during the pendency of this application, or an application claiming priority from this application.

Applicants respectfully traverse this Restriction Requirement on the grounds that it does not satisfy the prerequisites of M.P.E.P. § 816. Relative to a combination and a subcombination thereof, the Examiner must show that the combination as claimed does not require the

subcombination and that the subcombination is usable alone or in another combination. Under p.2, ¶2, of the Restriction Requirement (Paper no. 16), the Examiner states that:

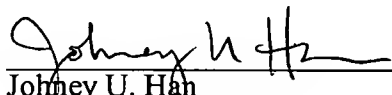
the combination as claimed does not require the particulars of the subcombination as claimed because, for example, in both independent claims 1 and 24 of the subcombination require the tubular member defining a lumen specifically requiring the tubular member to have a hollow lumen as opposed to a solid tubular member.

Applicants would draw the Examiner's attention to the claim language in Group II (claims 31-42, 44-48, 50-53, and 58-60) where independent claim 31 recites a catheter having a segment comprising the subcombination of the catheter section of Group I. The Examiner has not shown that the combination as claimed does not require the subcombination merely by pointing out that claims 1 and 24 specify a hollow lumen as opposed to a solid tubular member. A catheter must have a lumen to be operable. Therefore, Applicants must disagree with the Examiner's assertion and further contend that it would not be a serious burden on the Examiner to examine both Groups I and II. Said another way, it appears that each combination requires the details of the subcombination. Accordingly, Applicants respectfully request the withdrawal of the Restriction Requirement.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 290252021800. However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

Dated: February 13, 2001

By: 
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Registration No. 45,565

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